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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,815	12/06/2000	Daniel Newman	2717.100	9252
5514	7590	04/21/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/729,815	NEWMAN, DANIEL
	Examiner Calvin L Hewitt II	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 December 2000.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-67 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-67 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4 and 5</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-67 have been examined.

Claim Objections

2. Claims 10-12, 14 and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-12, 14, 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 5 recites “establishing user-defined settings that authorize payment of all fees that do not exceed a predetermined amount”. Claim 10, for example, recites “user-defined settings to accept a particular quantity of fees within a particular time period”. To one of ordinary skill, it is not clear how this limitation should be incorporated into the claim from which it depends, namely claim 5. Specifically, the processing defined by claim 5 is determined by a comparison of the “cost of content” and the user’s price ceiling. Therefore, the method steps of claim 5 do not depend on a “quantity of fees” and merely recite non-functional data (MPEP 2106 Section IV). On the other hand, if the limitation of claim 10 replaces the corresponding limitation in claim 5, such that the first limitation of claim 5 reads “establishing user-defined settings a particular quantity of fees within a particular time period”. If this is the case then claim 10 does not further limit the claim from which it depends (see Claim Objection section above).

Similarly, claims 11, 12, 14 and 15 are also rejected.

b. Claim 26 recites a user terminal performing processing without a processing program that is associated with a browser. However, an operating system is one such program and an operating determines all processing on a computer (e.g. printer, computer...etc.).

c. Claim 64 recites the limitation "user authorizes" in line 2. There is insufficient antecedent basis for this limitation in the claim.

5. Claims 10-12, 14 and 15 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: utilizing the user defined settings of accepting a particular quantity of fees within a particular time period to authorize a transaction.

Similarly, claims 11, 12, 14 and 15 are also rejected.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-9, 11, 13, 14, 16-23, 25, 27-37, 39, 40, 42-53, 55-57, and 63-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick, U.S. Patent No. 6,151,600.

As per claims 1-9, 11, 13, 14, 16-23, 25, 27-37, 39, 40, 42-53, 55-57, and 63-67, Dedrick teaches a method for enabling a user to obtain fee-based content over a network comprising:

- setting user defined parameters to accept all fees below a predetermined amount and storing said settings on a memory medium (abstract; column/line 7/60-9/8; column/line 9/59-10/33; column 14, lines 58-67)
- displaying a first portion of content, from a content provider, at a user location (figure 2; column 10, lines 24-33)
- determining whether a second portion of content requires payment of a fee by the user and displaying the second portion of content to the user when the fee for the second portion of content is accepted based on the user defined parameters (column/line 8/53-9/8; column 10, 23-33; column 11, lines 7-47; column 15, lines 1-21)
- accumulating a plurality of fees incurred by the user at a third party provider location, wherein the third party provider (e.g. internet service provider, financial institution or credit card company) pays the content provider the amount of the fees incurred by the user and the user makes a payment to the third party provider on a periodic basis and the user in turn pays the third party provider

- (column 7, lines 19-29; column 11, lines 7-48; column 13, lines 15-22; column 14, lines 15-32; column 15, lines 1-21)
- verifying the fees by the third party making payments to third party providers on a periodic basis (column 5, lines 38-43; column 7, lines 23-28; column 12, lines 32-40; column 14, lines 15-32)
- integrating the user-defined settings on a browser application (figure 2; column 2, lines 50-52; column 3, lines 23-60)
- accepting fees without prompting a user (column 8, lines 60-63)
- collecting content from a plurality of content providers utilizing HTML or other tags of each content provider website (figure 1)
- inputting a user-defined password prior to requesting content (column 3, lines 22-25; column 6, lines 1-6)
- generating an invoice as a function of fees incurred by a user (column 14, lines 15-32)

The Dedrick system enables a user to program an agent or search to retrieve specific content information based on a user profile or a specific query (e.g. price) (column 3, lines 22-60; column 7, lines 60-65; column 8, lines 18-25; column 10, lines 18-22). More specifically, the system allows a user to conduct a search for items or content such as "cellphones for under 50 dollars". Dedrick also teaches a user-programmed agent that returns an item or content to a user, when the item or content doesn't meet the exact criteria. Specifically, a user is

able to provide the agent with multiple criteria and the agent returning item or content information that meets only portion of said criteria (column 9, lines 1-9; column/line 9/59-10/3). Hence, a user may specify a "price", "date", "subject matter", and "content provider", and receive a search that only satisfies "subject matter" (e.g. cellphone for 60 dollars). Regarding the type of terminal used, it has been held that in order to be given weight in a method claim, the recited structure must affect the method in a manipulative sense (Ex parte Pfeiffer, 1962 C.D. 408 (1961)).

As per claims 63-65. Dedrick teaches a fee-based electronic information (e.g. content, items or services) over an electronic network that allows a user to specify parameters with which to retrieve said information (abstract; figure 2; column/line 8/18-9/8; column 10, lines 24-33). Dedrick teaches pre-authorizing said parameters through a user profile and overriding said parameters by allowing the system to retrieve electronic information wherein the information does not satisfy all the criteria (abstract; column 5, lines 32-53; column/line 6/36-7/18; column/line 8/60-9/8).

MPEP 2106, II, C states,

Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Therefore, these claims are broad as they are silent regarding what will be done if the content is not pre-authorized hence giving the claims their broadest

reasonable interpretation, a reasonable alternative is at least to perform the processing of Dedrick where the user defines criteria such that the system returns electronic information that meets only a portion of the criteria (column/line 8/60-9/8; column/line 9/59-10/3). This rationale also applies to claims 5, 33 and 66.

8. Claims 10, 12, 15, 24, 26, 38, 41 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick, U.S. Patent No. 6,151,600 in view of Fleming, U.S. Patent No. 5,953,710.

As per claims 10, 12, 15, 24, 26, 38, 41 and 54, Dedrick teaches an end-user constructing a user profile and using said profile to determine the search, retrieval, access and payment of content (column 3, lines 22-60; column 7, lines 60-65; column 8, lines 18-25; column 10, lines 18-22). However, Dedrick does not specifically recite controls on the quantity of fees. Fleming teaches a system for controlling a user's access to fee-based content based on the total or quantity of transactions (abstract; column 6, lines 59-67; column 12, lines 5-26). Fleming also teaches controlling a user's access on a periodic basis (column 14, lines 55-58) or renewal basis (column 12, lines 14-22). Hence, in light of the teachings of Fleming, it would have been obvious to one of ordinary skill to control a user's spending by limiting the user fixed amount of purchases on a weekly, monthly or yearly basis. Regarding messaging when fees exceed an accumulated amount,

the Fleming teaching is dedicated to purchases made via credit or debit card (abstract), hence, the Examiner takes Official Notice that messages to users indicating “insufficient funds” or “overdrawn” are old and well known. Fleming also teaches a user terminal interacting with a third party terminal (figures 6 and 8-11). Regarding the type of terminal used, it has been held that in order to be given weight in a method claim, the recited structure must affect the method in a manipulative sense (Ex parte Pfeiffer, 1962 C.D. 408 (1961)). Therefore, it would have been obvious to one of ordinary skill to allow users of the Dedrick system to store the “child” or supervised credit cards of Fleming in the user’s profile (‘600, column 5, lines 33-43) in order to monitor a child’s spending and/or protect against fraud (‘710, column 3, lines 10-32).

9. Claims 58-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick, U.S. Patent No. 6,151,600 in view of Berstis et al., U.S. Patent No. 6,282,653.

As per claims 58-62, Dedrick teaches a system for allowing users to access fee-based content (abstract; figure 2; column 10, lines 24-33; column 14, lines 15-32; column 15, lines 1-21). However, Dedrick does not specifically recite royalty payments to content providers. Berstis et al. teach a method and system for accumulating fees, accepting said fees from a user for accessing content and disseminating royalty payments based on said fee (column 8, lines 9-35; column

9, lines 45-53). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Dedrick and Berstis et al. in order to facilitate the efficient compensation of copyright holders for the use of their IP ('653, column 1, 30-67).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Barnes et al. teach a procurement system with spending controls
- Ng teaches shopping scouts
- Yagasaki teaches a system for searching for products online

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

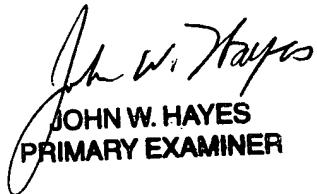
(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

April 15, 2004


JOHN W. HAYES
PRIMARY EXAMINER